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09/989,517	11/20/2001	Barbara B. Bruno	Bruno 380	1653

7590

02/26/2003

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EXAMINER

BARNIE, REXFORD N

ART UNIT

PAPER NUMBER

2643

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/989,517

Applicant(s)  
BRUNO ET AL.

Examiner  
REXFORD BARNIE

Art Unit  
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 20, 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-48 is/are allowed.
- 6) ☒ Claim(s) 49-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

*RJBarnie*  
REXFORD BARNIE  
PRIMARY EXAMINER

02/15/03

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Reissue Applications***

1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b)

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action.

### ***Claim Objections***

2. Claim 59 is objected to because of the following informalities: the claim is incomplete. Appropriate correction is required.

3. Claims 60-62 are objected to because of the following informalities: the claims are dependent to a latter claim 79 but for examination purposes would be treated as dependent on claim 49.

### ***Claim Rejections - 35 U.S.C. § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 49-82 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant's limitation including "receiving a request from a second party to undertake a request, undertaking a transaction in response to request from a second party and so forth" lacks support from the applicant's disclosure.

***Claim Rejections - 35 U.S.C. § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 78-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (US Pat# 6,246,755).

Regarding claims 78-82, Walker et al. teaches a telecommunication system wherein a user can purchase goods and/or services which can be charged to one's telephone prepaid account over one of a plurality of different networks in (see entire disclosure).

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8. Claims 78-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Taskett (US Pat# 6,115,458).

Regarding claims 78-82, Taskett teaches a prepaid system wherein a prepaid account can be used in contacting a service provider over a telephone network wherein charges associated goods and services can be applied to the account in (see disclosure, col. 7).

***Claim Rejections - 35 U.S.C. § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 49, 56-60 and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Pat# 6,246,755) in view of {Jagadish et al. (US Pat# 5,844,972) or Fraser (US Pat# 5,835,580) or Flynn et al. (US Pat# 5,223,699)}.

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Regarding claim 49, Walker et al. teaches a method and system for connecting a caller to a content provider capable of providing services over a plurality of network in (see col. 3 lines 40-48) wherein charges associated with goods and services provided by a content service provider can be billed to an account including a prepaid account in (see col. 1, fig. 2 and disclosure). The provided services including goods can be charged to the prepaid account by means of a telecommunication platform in (see figs. 1-2) but fails to teach in detail having a telephone communication billing system in communication with another platform for retrieval of subscriber information even though the control logic (processor) debits the account in real-time..

It's notoriously well known in the art to have two platforms namely; a telecommunication billing system in communication with platforms such as subscriber databases and so forth.

Jagadish teaches a customer profile based telephone card billing system wherein a billing system can communicate with a remote database to obtain information associated with a subscriber including prepaid account information and so on in (see figs.).

Fraser teaches a a telecommunication system comprising of a billing system which can communicate with a remote database which can have subscriber data in (see figs. 1-3).

Flynn teaches a recording and billing system in (see fig. 3) wherein a billing processor can be coupled to a remote platform could have information associated with a user of the card and so forth in (see fig. 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of the secondary references into that of walker et

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al. thus making it possible to complete and provide services and/or goods by charging the expenses to an account established by the user (prepaid account) for instance when the card is issued by an entity other than the service provider to which the user is connected and avoiding loss of revenue on behalf of content service providers.

Regarding claims 56-60, The combination teaches that a content service provide can provide a requested service to a calling party (user) in conjunction with a prepaid account (see Walker). According to Walker, the prepaid account can be recharged in (see col. 5 line 57-58). The combination including the secondary references teaches the possibility of being able to have billing platforms remote from other platforms.

Regarding claims 65-67, the combination including Walker teaches being able to charge purchases of goods and/or services to a prepaid account

11. Claims 50-55, 61-65 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Pat# 6,246,755) in view of {Jagadish et al. (US Pat# 5,844,972) or Fraser (US Pat# 5,835,580) or Flynn et al. (US Pat# 5,223,699)} and further in view of Hillson (US Pat# 6,118,860).

Regarding claims 50-55, The combination fails to teach the claimed subject matter in detail even though arguably there would be signaling between the processing network and the second party (content service provider) to provide the requested service. Hillson teaches a multi-media communication system wherein a content service provider can provide a requested service

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to a user including multi-media in (see disclosure) by using a prepaid account (see col. 12 lines 53-57).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Hillson thus making it possible to provide a request service from a content service provider which can then send the requested information by requesting a multi-media network to do so for the purpose of providing multi-media services..

Regarding claims 61-65, The combination including Hillson teaches being able to provide multi-media services which can be applied to a user's prepaid account wherein the services could include internet data services, video and so forth.

Regarding claim 68, see the explanation as set forth regarding claim 49 in addition to the fact the content provider can provide sales of products and goods over a network means including a non telephonic network (data network possibly) thus the content provider would have to signal the network to undertake a second request in response to a first request from a user.

12. Claims 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Pat# 6,246,755) in view of {Jagadish et al. (US Pat# 5,844,972) or Fraser (US Pat# 5,835,580) or Flynn et al. (US Pat# 5,223,699)} and further in view of Jalili (US Pat# 6,088,683).

Regarding claims 50-55, The combination fails to teach the claimed subject matter in detail even though arguably there would be signaling between the processing network and the second party (content service provider) to provide the requested service in response to a first request from a user. Jalili teaches a secure purchase transaction method using telephone number



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wherein a platform (merchant platform) can instruct another platform (processing center platform) to take an action in response to a request from a user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Jalili into that of the combination thus making it possible to provide a requested service by making a request or instruct an entity associated with the content service provider to provide the service.

13. Claims 68-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Pat# 6,246,755) in view of Rossman (US Pat# 5,809,415).

Regarding claims 68 and 69, Walker et al. teaches a telecommunication system wherein a calling party can be connected to a content service provider which provides goods and services over a number of network including the internet and so forth, purchased goods and/or services can be charged to one's prepaid account, a billing platform could read on a control logic platform (240) and the remote platform could read on one of the platforms including (300, 400, 260 of fig. 2) but fails to teach in detail the possibility of receiving a request from a content server at one end of the network in response to a service request from a user including to debit an account for a service. It's notoriously well known to debit an account for a service or determine whether the account has enough money to establish a service call. Rossman teaches a method and architecture for an interactive two way data communication network wherein according to (figs. 12-13 and col. 37 line 23-col. 38 line 7), a request can be received in conjunction with a server.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Rossman into that of Walker thus making it possible to authentic and debit a prepaid account associated with a user for services provided regarding claims 70-77, The combination including Walker teaches the possibility of being able to determine one's account, recharge the account and so forth in conjunction with purchases of a user from a content service provider which includes goods and/or services.

***Allowable Subject Matter***

14. Claims 1-48 are allowed.

***Conclusion***

15. Any inquiry concerning this communication or earlier communication from the examiner should be directed to REXFORD BARNIE whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to (703) 872-9314 and labeled accordingly (Please label

**"PROPOSED/INFORMAL" or "FORMAL"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 306-0377.

Rexford Barnie  
Patent Examiner  
RB 02/13/03.

*RBarnie*  
REXFORD BARNIE  
PRIMARY EXAMINER